

Address: Assistant Commissioner for Patents
Box PCT
Washington, D.C. 20231

This is a decision in response to Applicants' Renewed Petition under 37 C.F.R. 1.181 received 15 September 2000. The petition is GRANTED.

BACKGROUND

On 17 June 1999, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 USC 371 (Form PCT/DO/EO/905) indicating that an oath or declaration and the surcharge for filing the oath or declaration later than 30 months from the priority date must be filed in U.S. Serial No. 08/308,860. The notification set a one-month time limit in which to respond.

On 09 November 1999, applicants filed a Status Request regarding the status of the U.S. national stage filing of PCT/GB97/03317. Applicants stated that the return-receipt postcard acknowledge Office receipt of Form PTO-1390, filed 26 May 1999, had not been received.

On 28 March 2000, the United States Designated/Elected Office mailed a Notification of Abandonment of U.S. Serial No. 08/308,860 under 35 USC 371 and 37 CFR 1.494 or 1.495 (Form PCT/DO/EO/909) indicating that the applicant failed to respond to the Notification of Missing Requirements.

On 03 April 2000, applicants filed a petition to revive U.S. Serial No. 09/423,399 under 37 CFR 1.137(a) including, inter alia, a copy of a return-receipt post card stamped with Serial No. 09/423,399, a statement that the abandonment was unavoidable, a copy of Form PTO 1390, and applicants' mail log for the dates 17 June through 6 July 1999. Applicants noted receipt of a

Notice of Abandonment of Serial No. 09/308,860, and that while identifying data other than the serial number matched, Applicants had no record of an application bearing the Serial No. 09/308,860.

On 16 June 2000, the United States Designated/Elected Office mailed a Response to Status Inquiry indicating that the presumption that Office Notifications were properly mailed may be overcome by establishing a showing that they were not in fact received, or by filing a petition to revive under 37 CFR 1.137(a). The showing requires firstly a statement attesting to the fact that a search of the file jacket and docket records indicate that the Office action was not received, and secondly that a copy of the docket record where the non-received Office action would have been entered had it been received and docketed must be attached to and referenced in the statement.

On 21 June 2000, applicants filed a letter (a status inquiry, treated as a petition under 37 CFR 1.181), asking for Office review of the Petition to Revive.

On 14 August 2000, applicants filed a Supplement to Petition to Revive including practitioner's docket report for the dates 16, 17, & 18 July 1999.

On 05 September 2000, the United States Designated/Elected Office mailed a Response to the petition filed 21 June 2000 and the Supplement to Petition filed 14 August 2000, indicating that practitioner's docket report for the date 17 July 1999 was not accompanied by applicants' statement referencing the docket report and attesting to the fact that a search of the file jacket and docket records indicate that the Office action was not received. The Response noted that Office error had resulted in assignment of new Serial No. 09/423,399 to the transmittal letter submitted with the status Request filed 09 November 1999, and that all papers in application Serial No. 09/423,399 had been transferred to application Serial No. 09/308,860.

On 15 September 2000, applicants filed the instant Renewed Petition Under 37 CFR 1.181 requesting reconsideration of the Office decision mailed 05 September 2000, stating that a search of the file jacket and docket records indicates that the Office action was not received, and attaching copies of practitioner's docket reports for the dates 16, 17, & 18 July 1999.

DISCUSSION

Although USPTO records indicate that the Notification of Missing Requirements (PCT/DO/EO/905) was mailed, the showing submitted by Applicant, in compliance with the the revised policy published at 1156 OG 53, *Withdrawing the Holding of Abandonment When Office Actions Are Not Received*, is sufficient to establish that the Notification was not received.

CONCLUSION

For the reason above, the petition under 37 CFR 1.181 is GRANTED.

The holding of abandonment of application Serial No. 09/308,860 will be withdrawn.

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, D.C., 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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